

Docket No. SP01-270 (015275-060008)
Patent

REMARKS

Claims 1-12 and 27 are pending, and new claims 28-34 have been added. By this amendment, claims 13-26 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue these canceled claims in a continuation or divisional application.

Applicants have amended claim 1 to replace the terms "gDNA," "3'UTR," and "predetermined sequence" with "genomic DNA (gDNA)," "3' untranslated region (3'UTR)," and "a PCR product in the predetermined band," respectively. Applicants have also deleted the term "exon" from claim 1, and added new claim 28 to prescribe methods for amplifying genomic sequences from "an exon of a gene defined by computer software." Applicants believe that the above amendment to claim 1 are purely cosmetic and, therefore, do not introduce new matter. Applicants have further amended claim 1 to recite "depositing a sequence amplified by said second polymerase chain reaction to a substrate of an array." This amendment is supported at least by original claim 2 and paragraph 36 of the specification.

In addition, Applicants have amended claim 2 to delete the term "final," claim 3 to replace the phrase "final amplified sequences are" with "amplified sequence is," claims 4-5 and 27 to delete the term "or exon," claim 11 to replace the phrase "said method can generate PCR products that contain" with "said amplified sequence contains," and claim 12 to replace the term "is" with "has." Applicants believe that these amendments to claims 2-5, 11-12 and 27 are purely cosmetic and, therefore, do not introduce new matter.

Moreover, Applicants have added new claims 28-34. Claim 28 is supported at least by original claim 1, and claims 29-34 are supported at least by paragraphs 31-43 of the specification.

Applicants respectfully submit that the amendments to the claims and the addition of new claims do not introduce new matter. Accordingly, entry of the amendments is respectfully requested.

Claim Objection

On page 2, the Office Action objects claim 3 for reciting "sequences are the sequence." Applicants have amended claim 3 to replace the phrase "final amplified sequences are" with "amplified sequence is." Applicants believe that this amendment overcomes the Examiner's objection. Reconsideration of the objection to claim 3 is, therefore, respectfully requested.

Claim Rejection Under 35 U.S.C. §112, Second Paragraph

On page 3, the Office Action rejects claims 1-12 and 27 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. In particular, the Office Action rejects claim 1, 4-10, and 27 for reciting the terms "UTR" and "gDNA," and claims 2-3 and 11-12 for depending from claim 1. The Office Action

Docket No. SP01-290 (015275-060008)

Patent

also rejects claim 1 for reciting the phrase "corresponding to," and claims 2-12 and 27 for depending from claim 1. For the reasons set forth below, Applicants respectfully traverse the rejection.

Applicants have amended claim 1 to recite "genomic DNA (gDNA)" and "3' untranslated region (3' UTR)." In addition, Applicants have deleted the phrase "corresponding to" from claim 1. Applicants submit that these amendments obviate the Examiner's rejection of claims 1-12 and 27. Reconsideration of the §112 rejection of these claims is, therefore, respectfully requested.

Claim Rejection Under 35 U.S.C. §102(a)

On pages 3-5, the Office Action rejects claims 1-2, 5-10, 12, and 27 under 35 U.S.C. §102(a) as allegedly being anticipated by U.S. Patent No. 6,274,332 (hereinafter "Keating"). Applicants respectfully traverse the rejection.

Applicants respectfully submit that Keating fails to teach or suggest each and every element of claim 1. Keating describes PCR amplification of genomic sequences for the detection of mutations. Keating, however, neither teaches nor suggests amplifying genomic sequences from the 3'UTR regions. Moreover, Keating fails to teach or suggest depositing the amplified sequences to a substrate to make DNA arrays. Accordingly, Applicants respectfully submit that Keating fails to teach or suggest each and every element of claim 1.

Because claims 2-12 and 27 depend from claim 1, Applicants submit that Keating also fails to teach or suggest each and every element of these claims. Based on the above reasons, Applicants respectfully request reconsideration and withdrawal of the §102(a) rejection of claims 1-12 and 27.

In regard to new claim 28, Applicants believe that Keating fails to teach or suggest using computer software to determine exons in a genomic sequence. In addition, as noted above, Keating neither teaches nor suggests depositing amplified genomic sequences to a substrate to make DNA arrays. As a result, Applicants respectfully submit that Keating neither anticipates nor renders obvious claim 28.

Docket No. SP01-290 (015275-060008)
Patent

CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that his application is in condition for allowance. Favorable consideration and prompt allowance of the claims are earnestly solicited. Although Applicants believe that no fee is due, the Commissioner is hereby authorized to charge any payment deficiency to deposit account number 19-2380 referring to attorney docket number 015275-060008.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



Raymond Van Dyke

Reg. No. 34,746

Date: March 9 2005

Nixon Peabody LLP
Suite 900
401 9th Street, N.W.
Washington, D.C. 20004-2128
Tel: (202) 585-8000
Fax: (202) 585-8080

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.